

FEB 28 2002



UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Lee R. Osman
Dorsey & Whitney, LLP
Suite 4700
370 Seventeenth Street
Denver, CO 80202-5647

In re Application of	:	
TORPY et al	:	
Application No.: 09/787,496	:	
PCT No.: PCT/AU99/00791	:	
Int. Filing Date: 17 September 1999	:	DECISION
Priority Date: 18 September 1998	:	
Atty. Docket No.: 10032.00	:	
For: THIN FILM HEATING	:	
ELEMENT	:	

This is a decision on applicants' "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" filed in the U.S. Patent and Trademark Office (PTO) on 17 October 2001, which has been treated as a petition under 37 CFR 1.47(a) requesting that the application be accepted without the signature of missing joint inventor David M. Gehrig.

BACKGROUND

On 17 September 1999, applicants filed international application No. PCT/AU99/00791 which claimed a priority date of 18 September 1998, and which designated the United States.

On 04 April 2000, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date, and as a result the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e. 18 March 2001.

On 16 March 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the basic national fee and a copy of the international application.

On 24 April 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 17 October 2001, applicants filed the present petition which was accompanied by, inter alia, a declaration executed by joint inventor Torpy, the surcharge for late filing of the declaration, a statement of facts in support of the petition by Paul Le Vavasasseur, and an authorization to charge any additional fees to counsel's deposit account.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicants have satisfied items (1), (3) and (4) above.

With regards to item (1), the requisite \$130 petition fee has been charged to counsel's deposit account, No. 04-1415, as authorized in the response.

Concerning item (2) above, the petition asserts that the present application should be accepted for entry into the national stage based on the fact that the 1.47(a) applicant "has been unable to locate or contact the second inventor, David M. Gehrig." However, a review of the facts set forth in Mr. Le Vavasasseur's statement reveals that instead it appears that Mr. Gehrig has in fact been located, he just has not responded to the efforts to obtain his signature. Therefore, the petition is properly treated as a request to accept based on the refusal of the co-inventor to join in the present application for patent.

Section 409.03(d) of the Manual Of Patent Examining Procedure (MPEP), under the heading "REFUSAL TO JOIN" states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the

inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the application file reveals that item (2) cannot be said to have been satisfied at this time in that Mr. Le Vavassey's statement is insufficient. Specifically, it is unclear whether the steps outlined in the statement were performed by Mr. Le Vavassey or by someone else. Further, it has not been established that Mr. Gehrig has been presented with a complete copy of the application papers (specification, including claims, drawings, and oath or declaration). Additionally, the statement has not been accompanied by any documentary evidence. In this regard, Mr. Le Vavassey's statement sets forth that a copy of the cover letter which accompanied the papers sent to Mr. Gehrig on 03 May 2001, was included with the present petition. However, a review of the papers which accompanied the petition reveals that no such cover letter was included. Finally, it is unclear why no further attempts were made to contact Mr. Gehrig at his home number, a number where apparently someone was present at least on the date the attempt was made, rather than the repeated attempts to Mr. Gehrig's mobile phone, a number which never was answered or had an indication that it was in use.

Therefore, in that applicants have not satisfied item (2) above, the petition under 37 CFR 1.47(a) may not be properly granted at this time.

CONCLUSION

For the reasons above the petition is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

A proper response must include either (a) a declaration executed by all of the inventors, or (b) an acceptable showing that the missing joint inventor has refused to execute the application as discussed above.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Richard R. Cole
Legal Examiner
PCT Legal Affairs

(703)305-6639
RRC:rrc